

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks.

Status of Claims

Claims 1, 4, 10, and 17 have been amended and claim 21 has previously been canceled without prejudice or disclaimer of the subject matter contained therein. Claims 1-20 are thus currently pending in the application of which claims 1 and 17 are independent.

No new matter has been introduced by way of the amendments above. Entry thereof is therefore respectfully requested.

Summary of the Office Action

Claims 1-3, 7-10, 12-15, and 17-19 were rejected under 35 U.S.C. 102(c) as allegedly being anticipated by U.S. Patent No. 6,611,501 to Owen et al. (hereinafter "Owen").

Claims 4-6, 11, 16, and 20 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Owen in view of U.S. Patent No. 6,385,646 to Brown et al. (hereinafter "Brown").

Reopen Prosecution Following Board Decision

37 C.F.R. § 1.114 recites, in pertinent part, that:

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(c) prior to the earliest of:

- (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
- (2) Abandonment of the application; or

(3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of the civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

37 C.F.R. § 1.198 recites that:

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

MPEP 1214.06 recites, in pertinent part that “[t]he proceedings in an application or ex parte reexamination preceding our terminated as of the date of the expiration of the time for filing court action.” In addition, [t]he time for seeking review of a decision of the Board by the Court of Appeals for the Federal Circuit or in the U.S. District Court for the District of Columbia is the same for both tribunals, that is, two months...”

The decision by the Board in the present application was issued on June 10, 2010 and mailed on June 14, 2010. Thus, according to MPEP 11214.06, which cites to 37 C.F.R. § 1.197, the proceedings of this application do not terminate until August 10, 2010, at the earliest, which is the end of the two month time period for seeking review of the Board decision. As such, the mailing of the Notice of Abandonment on July 20, 2010 is clearly improper and should therefore be withdrawn. Submitted concurrently herewith is a Petition to Withdraw Holding of Abandonment to thus have the holding of abandonment in this case withdrawn.

The present Request for Continued Examination (RCE) is therefore being submitted prior to abandonment of the application and is thus a proper filing under 37 C.F.R. § 1.114. In addition, the amendments made to the claims of the present application contain features that have not already been adjudicated. For instance, independent claims 1 and 17 have been

amended to recite that the service system determines a context of the existing communication session based upon context data concerning the existing communication session. In addition, these claims have been amended to recite that the service system selects an appropriate assistant entity from a group of assistant entities based upon the determined context of the existing communication session. These added features have not been considered by the Examiner or the Board.

As such, reopening of prosecution of the present application is respectfully requested in light of the present RCE filing under 37 C.F.R. § 1.114 as set forth in 37 C.F.R. § 1.198.

Claim Rejection Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

The heading on page 4, paragraph 2 of the Examiner's Answer mailed on January 2, 2008 (hereinafter the "Examiner's Answer") does not recite claims 17-19, but the rejection that follows that heading includes these claims. As such, it appears that the heading on page 4, paragraph 2 of the Examiner's Answer contains a typographical error and should also have recited claims 17-19.

Claims 1-3, 7-10, 12-15, and 17-19 were rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Owen. This rejection is respectfully traversed for at least the following reasons.

Independent claim 1, as amended, recites:

A method of inviting an assistant entity into an existing communication session established by a service system with an associated transport mechanism for the exchange of data across a network between endpoint entities joined to the session comprising the steps of:

- (a) receiving a request from a first endpoint entity in the service system to invite an assistant entity into the existing communication session, wherein the assistant entity is configured to assist the first endpoint entity with a property of the existing communication session;
- (b) determining, by the service system, a context of the existing communication session based upon context data concerning the existing communication session;
- (c) selecting, by the service system, an appropriate assistant entity from a group of assistant entities based upon the determined context of the existing communication session; and
- (d) joining, by the service system, the selected assistant entity to the existing session.

Independent claim 17, as amended, recites:

A service system comprising:

a session entity for establishing communication sessions and controlling the joining of endpoint entities to each such session;

a transport entity for establishing a transport mechanism for each session established by the session entity, the transport mechanism being arranged to allow the exchange of data across a network between endpoint entities joined to the session;

request-reception means configured to receive a request from a first endpoint entity already joined to a session and constituted by a party having an endpoint system connected to the network, the request being arranged for requesting the presence of an

assistant entity in the session and directly or indirectly indicating the identity of the existing communication session, wherein the assistant entity is configured to assist the first endpoint entity with a property of the existing communication session;

context-determination means configured to determine a context of an existing communication session between endpoint entities based upon context data concerning the existing communication session and

assistant-selection means configured to be responsive to the receipt of said request by the request-reception means to select an appropriate assistant entity from a group of possible assistant entities based upon the determined context of the existing communication session, the assistant-selection means being operative to cause the session entity to join the selected assistant entity to the session.

Support for the amendments to independent claims 1 and 17 may at least be found in the original version of claims 1 and 5, and the disclosures contained on page 21, line 20-page 22, line 5, page 33, lines 25-30, and page 47, lines 20-23 of the originally filed Specification.

It is respectfully submitted that Owen fails to at least disclose the features added herein to independent claims 1 and 17. Instead, Owen discloses a connection management system for setting up particular connection configurations between users in a communications network. *Owen*, Abstract. In this regard, Owen discloses user agents 107 that represent and act on behalf of user to perform various functions, for instance, as listed in column 14, lines 30-44 of Owen. As recited therein, the user agents may be set to control when calls are received or the types of information that may be communicated to a caller by a callee. Owen also discusses terminal agents 102 that are responsible for representing a terminal, such as, obtaining a precise location of a terminal. *Owen*, column 12, lines 16-20.

In the rejection of independent claims 1 and 17, page 5 of the Examiner's Answer asserts that "an 'appropriate' user agent receives requests from users to establish service sessions." Thus, it appears that the Examiner's Answer is equating the user agent in Owen with the claimed assistant entity. This assertion, however, is incorrect because the user agent in Owen is not selected based upon a determined context of an existing communication

session by a service system. Instead, each user has their own user agent, which each user triggers when making a call. *Owen*, column 18, lines 35-36. See also, *Owen*, column 12, lines 4-15, which states that the “user agent 107 represents and acts on behalf of a user. It receives requests from users to establish service sessions, or to join existing service sessions, and creates or negotiates with existing service sessions as appropriate.”

In addition, *Owen* fails to disclose that a service system determines a context of the existing communication session based upon context data concerning the existing communication session. Moreover, *Owen* fails to disclose that the service system selects an appropriate assistant entity from a group of assistant entities based upon the determined context of the existing communication session and joins the selected assistant entity to the existing session as recited in independent claims 1 and 17. Instead, as discussed above, the user agents are previously assigned to each user to assist their respective users with making calls and thus are not selected based upon a context of an existing communication session. In addition, because the user agent in *Owen* is actively involved in the calls made by the user, the user agent is also not joined into the existing session.

For at least the foregoing reasons, it is respectfully submitted that *Owen* fails to disclose each and every feature recited in independent claims 1 and 17 and thus cannot anticipate these claims. The Examiner is therefore respectfully requested to withdraw the rejection of independent claims 1 and 17 and the claims that depend therefrom.

The claims that depend upon independent claims 1 and 17 are allowable over *Owen* for reasons in addition to their respective dependencies upon allowable independent claims 1 and 17. For instance, claims 2 and 18 recite that the assistant entity is a customer service representative and associated endpoint system. The Examiner’s Answer asserts that Figure 5

of Owen discloses this claimed feature. It is not at all clear as to which element or elements in Figure 5 of Owen are construed as comprising a customer service representative because Figure 5 of Owen merely depicts five principal objects that perform various functions of the user agent 107. *Owen*, column 12, line 55-column 13, line 24. As is clearly seen from that cited section of Owen, none of the five objects depicted in Figure 5 of Owen can reasonably be construed as a customer service representative and thus, Owen fails to anticipate claims 2 and 18.

Claim Rejections Under 35 U.S.C. § 103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S.398, 82 USPQ2d 1385 (2007):

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, “[a]ll claim limitations must be considered” because “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would

have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S.398, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006), “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness.”

Therefore, if the above-identified criteria and rationales are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 4-6, 11, 16, and 20 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Owen in view of Brown. This rejection is respectfully traversed for at least the following reasons.

Claims 4-6, 11, 16, and 20 are dependent from one of independent claims 1 and 17. Thus, they are also believed to be allowable over Owen for at least the same reasons as set forth to independent claims 1 and 17 above. In addition, the Examiner’s Answer relies upon Brown for its disclosure of the establishment of voice communications in an Internet

environment. As such, the Examiner's Answer has not and cannot reasonably rely upon the disclosure contained in Brown to make up for the deficiencies in Owen discussed above with respect to independent claims 1 and 17.

Accordingly, even assuming for the sake of argument that one of ordinary skill in the art were somehow motivated to combine Owen and Brown as suggested in the Examiner's Answer, the proposed combination would still fail to result in independent claims 1 and 17.

For at least the foregoing reasons, it is respectfully submitted that Owen and Brown, considered individually or in combination as suggested in the Examiner's Answer fails to render claims 4-6, 11, 16, and 20 *prima facie* obvious. The Examiner is therefore respectfully requested to withdraw the rejection of these claims.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited. Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below.

PATENT

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Please grant any required extensions of time and charge any fees due in connection with this request to Deposit Account No. 08-2025.

Respectfully submitted,

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